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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,101	10/11/2001	Michael J. Goldberg	6954-1	8764
21324	7590	10/21/2003		
HAHN LOESER & PARKS, LLP TWIN OAKS ESTATE 1225 W. MARKET STREET AKRON, OH 44313			EXAMINER BUI, LUAN KIM	
			ART UNIT 3728	PAPER NUMBER
			DATE MAILED: 10/21/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/975,101

Applicant(s)

GOLDBERG, MICHAEL J.

Examiner

Luan K Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 16, 17 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17, 19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Newly submitted claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the product as claimed can be made by another and materially different process such as by providing the tubular applicator having a first end secured to the sleeve opening.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 23 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4, 5, 7-9, 12, 14, 19 and 21 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Young et al. (6,345,911; hereinafter Young'911). Young'911 a bag/cover (10) comprising a flexible plastic sleeve (12) having a top wall, a bottom wall, two side walls and a rear wall connecting the top wall, the bottom wall and two side walls at a first end of the

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sleeve, a sleeve opening (16) defined by the top wall, the bottom wall and the two side walls at a second end of the sleeve, and an applicator (14, 15) formed from semi-rigid plastic material secured to the sleeve opening by heat sealing, welding, adhesive or the like (column 4, line 1). The applicator comprising a tubular member having a first end secured to the sleeve opening and a second end. The bag/cover of Young'911 is inherently capable of receiving a hand-held electronic device and allowing the electronic device to be selectively removed from the sleeve.

4. Claims 1, 2, 4, 5, 7-9, 12, 14, 19 and 21 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Mazzocchi (5,839,831). Mazzocchi a bag/cover (10) comprising a flexible plastic sleeve (71, 72) having a top wall, a bottom wall, two side walls and a rear wall connecting the top wall, the bottom wall and two side walls at a first end of the sleeve, a sleeve opening (18) defined by the top wall, the bottom wall and the two side walls at a second end of the sleeve, and an applicator (64, 66) secured to the sleeve opening by heat sealing or adhesive (column 5, lines 24-26 ). The applicator comprising a tubular member having a first end secured to the sleeve opening and a second end. The bag/cover of Mazzocchi is inherently capable of receiving a hand-held electronic device and allowing the electronic device to be selectively removed from the sleeve.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 6, 10, 11, 13, 16, 17 and 22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (6,345,911; hereinafter Young'911) or Mazzocchi (5,839,831) in view of Ambler et al (4,838,327; hereinafter Ambler'327). Young'911 or Mazzocchi discloses the bag/cover (10) as above having all the limitations of the claims except for the applicator being releasably secured to the sleeve opening. Ambler'327 shows a bag/cover (10) comprising a flexible plastic sleeve (12) and an applicator (14) is releasably secured to a sleeve opening (Figure 1). It would have been obvious to one having ordinary skill in the art in view of Ambler'327 to modify the bag/cover of Young'911 or Mazzocchi so the applicator is releasably secured to the sleeve opening to reduce the cost of manufacture by reusing the applicator with other bags/covers. With regard to the sleeve being transparent as claimed, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the sleeve of Young'911 or Mazzocchi so the sleeve is made from transparent material to allow visual to the contents within the sleeve, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

#### ***Response to Arguments***

Applicant's arguments with respect to the rejected claims have been considered but are deemed to be moot in view of the new grounds of rejection.

In response to applicant's argument that "Young does not expressly or inherently teach that bag or applicator is capable of receiving an electronic device" is noted. This is not persuasive because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Also, the claims as recited do not claim an electronic device in combination with the sleeve and applicator.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (703) 305-5861. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to TC 3700 Customer Service at (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 872-9301. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb  
October 17, 2003



Luan K. Bui  
Primary Examiner